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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3653

In re

Patent Application of

Gilbert Dominguez

Application No. 09/760,958

Confirmation No. 5489

Filed: January 16, 2001

Examiner: Daniel K. Schlak

"DYNAMIC SORTATION OF ITEMS IN A
CONTAINERIZATION SYSTEM"

I, Karen Kline, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on the date of my signature.

Karen Kline

Signature

3/23/04

Date of Signature

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GROUP 3600

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sincerely,

In the Restriction requirement dated February 23, 2004, the Examiner identifies three groups of inventions claimed in the present application, and requests an election of one group for prosecution on the merits. The Applicant hereby provisionally elects, with traverse, Group I (Claims 1-8) for further prosecution on the merits. The Applicant respectfully disagrees with the appropriateness of the Restriction requirement and requests reconsideration of this requirement for the reasons setout below.

Chapter 800 of the MPEP states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." See MPEP 803. The Applicant respectfully asserts that examination of the entire application can be made without serious burden. Specifically, the present application contains twenty-two claims separated into three claim sets based upon three independent claims (claims 1, 9, and 16). The

Examiner has divided the present application into three groups corresponding with each claim set. However, as identified by the Examiner, all three claim sets are classified in the same class, which is class 700. Furthermore, the claims of Group 1 (claims 1-8) and Group 3 (claims 16-23) have many similar limitations. Thus, the search for art showing the limitations of Group 1 will necessarily be the same search needed for Group 3. Additionally, the claims of Group 1 and Group 3 are directed to methods. It is generally understood that many methods are performed by an apparatus. Consequently, most prior art does not disclose a method without providing an associated apparatus to facilitate the method. Thus, to properly search the claims of Group 1 and/or Group 3, the Examiner will have to at least search for an apparatus similar to the one claimed in the claims of Group 2. Since only twenty-two claims (or three claim sets) are pending, all claims are in the same class, and a search for one Group or claim set will substantially complete the search of another Group or claim set, the Applicant respectfully submits that search and examination of an entire application can be made without serious burden. Therefore, “the examiner must examine [the entire application] on the merits,” even though it may include claims to independent or distinct inventions. See MPEP 803.

Furthermore, the Examiner has not established that examination of three claim sets, all directed to subject matter in class 700, would be a serious burden. The Examiner is obligated to show a *prima facie* case of a serious burden with an appropriate explanation. See MPEP 803. The Examiner has not provided a showing, nor has he provided an explanation as to why examination of the entire application would be a serious burden.

In the alternative, if the Examiner finds the above arguments unpersuasive, the Applicant respectfully submits that the Examiner’s division of the claims into three groups is incorrect. Specifically, Groups I and III should be combined. As discussed above, both of these claim sets are method claims having many similar limitations. Thus, the search required for one group will substantially complete the search for the other group.

Summarizing the above, the provisional election of Group I is made with traverse and the Applicant respectfully requests reconsideration of the restriction requirement. Early,

favorable consideration of the application is respectfully requested. The Examiner is invited to contact the undersigned if he believes it would be helpful.

Respectfully submitted,



Derek C. Stettner
Reg. No. 37,945

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